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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/945,342	08/31/2001	Grace Li	4316/19	1433
22440	7590	04/06/2006	EXAMINER	
GOTTLIEB RACKMAN & REISMAN PC 270 MADISON AVENUE 8TH FLOOR NEW YORK, NY 100160601			BOYD, JENNIFER A	
			ART UNIT	PAPER NUMBER
			1771	

DATE MAILED: 04/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	09/945,342		LI ET AL.	
	<b>Examiner</b>		<b>Art Unit</b>	
		Jennifer A. Boyd	1771	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) ☒ Responsive to communication(s) filed on 23 January 2006.

2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) ☒ Claim(s) 2-8, 10-14, 16-18 and 29-35 is/are pending in the application.

4a) Of the above claim(s) 29-35 is/are withdrawn from consideration.

5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.

6) ☒ Claim(s) 2-8, 10-14, 16-18 is/are rejected.

7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.

8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All    b) ☐ Some \* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) <input type="checkbox"/> Notice of References Cited (PTO-892) 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____. 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) 6) <input type="checkbox"/> Other: _____.
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**DETAILED ACTION*****Response to Amendment***

1. The Applicant's Amendments and Accompanying Remarks, filed January 23, 2006, have been entered and have been carefully considered. Claims 5 and 13 are amended, claims 29 – 35 are added and claims 2 – 8, 10 – 14, 16 – 18 and 29 – 35 are pending. The rejection over previously applied Banks (US 4,921,702) has been amended below to account for Applicant's amendments to the independent claims. The invention as currently claimed is unpatentable for reasons herein below.

***Election/Restrictions***

2. Newly submitted claims 29 – 35 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 29 – 35 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03. Inventions of Group I: claims 2 - 8, 10 – 14 and 16 – 28 and Group II: claims 29 - 35 are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). In the instant case the product as claimed can be used in a materially different

process of using that product such as placing the article in a litter box and the product neutralizes the liquid waste when the animal uses the litter box.

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

***Claim Rejections - 35 USC § 102/103***

4. Claims 2 – 7, 10 – 14 and 16 – 17 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Banks et al (US 4,921,702).

Banks is directed to a sheet material for treating wounds in plant matter (Title).

As to claims 5 and 13, Banks teaches an absorbent sheet comprising a layer of sheet material (distal layer), a permeable layer (proximal layer) and between the layers liquid absorbing solid particles and/or fibrous absorbent material (Abstract). Banks teaches that the proximal layer can be a permeable layer (column 3, lines 35 – 45) and the distal layer can be an impermeable layer (column 3, lines 64 – 68). The absorbent material may contain in one embodiment: 25 – 75% particulate absorbent, 5 – 20% of high melt flow PE as adhesive and 1.5 g per square meter of active fungicide (column 4, lines 45 – 60). Banks teaches that the liquid absorbent particles may comprise cross-linked polyacrylic acid derivates (column 2, lines 55 – 65). Banks teaches that the laminate may be in the form of discrete pieces of a suitable shape and size, preferably bonded or sealed around their peripheries or may be in the form of a roll or elongated web with transverse perforations at regular intervals (column 6, lines 1 – 10).

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As to claims 2 and 10, Banks teaches that the permeable layer may comprise a cellulose fluff layer, a cellulose tissue or a perforated woven or nonwoven synthetic polymeric material (column 3, lines 35 – 45).

As to claims 3 and 11, Banks teaches that the impermeable layer may comprise any suitable polymeric sheet material such as polyethylene (column 4, lines 1 – 5).

As to claims 4 and 12, Banks teaches that the absorbent polymer may comprise cross-linked sodium polyacrylate (column 2, lines 55 – 65).

As to claims 6 – 7, 14 and 16, Banks teaches that the adhesive can comprise high melt flow index polyethylene (column 4, lines 45 – 60).

As to claim 17, Banks teaches that the laminate may be in the form of a roll or elongated web with transverse perforations at regular intervals (column 6, lines 1 – 10).

It should be noted that the recitations of “for collecting excreted liquid animal waste” and “for absorbing and neutralizing said liquid animal waste” are not given patentable weight at this time since the prior art meets the structural and/or chemical limitations set forth and there is nothing on record to evidence that the prior art product could not function in the desired capacity. The burden is shifted upon the Applicant to evidence the contrary. Furthermore, the phrase “adapted to be worn by an animal along where said waste is excreted” is an “adapted to” type limitation. It has been held that the recitation that an element is “adapted to” perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

***Claim Rejections - 35 USC § 103***

5. Claims 8 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Banks et al (US 4,921,702).

Banks discloses the claimed invention except for that the article has a thickness of between about 0.015 and 0.025 inches as required by claims 8 and 18. It should be noted that thickness of the article is a result effective variable. As the thickness increases, the article becomes stiffer, stronger and bulkier. As the thickness decreases, the article becomes more flexible, thin and fragile. It would have been obvious to one having ordinary skill in the art at the time the invention was made to create an article with a thickness ranging from 0.015 and 0.025 inches since it has been held that where general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 220 F.2d 454 USPQ 233 (CCPA 1955). In the present invention, one would have been motivated to optimize the thickness in order to create an article having appropriate flexibility and strength suitable for disposable absorbent pads.

***Response to Arguments***

6. Applicant's arguments filed January 23, 2006 have been fully considered but they are not persuasive.

Applicant argues that while Banks arguably teaches an absorbent material comprising a permeable inner layer, an impermeable out layer and liquid absorbing particles comprising cross-linked sodium polyacrylate disposed therebetween, the Banks teaching has nothing to do with a waste collection pad for collecting liquid animal excrement. Intended use recitations and other

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types of functional language cannot be entirely disregarded. However, in apparatus, article, and composition claims, intended use must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967); *In re Otto*, 312 F.2d 937, 938, 136 USPQ 458, 459 (CCPA 1963) (The claims were directed to a core member for hair curlers and a process of making a core member for hair curlers. Court held that the intended use of hair curling was of no significance to the structure and process of making.) In this case, although Banks is directed to a sheet material for treating wounds in plant matter, the sheet material is capable of functioning as an article for collecting excreted liquid animal waste. Banks discloses that the sheet material is absorbent and the super absorbent polymer granules are those that are traditionally used in disposable nappy liners for babies and in incontinence pads (see column 2, lines 10 – 20 and lines 25 – 35). Furthermore, it has been held that a recitation with respect to the manner in which a claimed article is intended to be employed does not differentiate the claimed article from a prior art article satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987). The burden is upon the Applicant to prove that the absorbent sheet material of Banks et al. cannot be used for Applicant's desired applications.

### ***Conclusion***

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer A. Boyd whose telephone number is 571-272-1473. The examiner can normally be reached on Monday thru Friday (8:30am - 6:00pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Jennifer Boyd

March 22, 2006

  
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